In the Abstract:

Please add the following Abstract of the Disclosure after the claims in the above identified patent application:

--Oligomeric compounds comprising a plurality of aminodiol monomer subunits joined by linking groups are provided, as well as libraries of such compounds and processes for preparing the oligomeric compounds and libraries.--

REMARKS

Claims 31-56 are pending in this application.

The Office Action includes rejections under 35 U.S.C. §§ 103(a), 112, second paragraph, and under the judicially-created doctrine of obviousness-type double patenting. In view of the remarks to follow, Applicant requests that these rejections be reconsidered and withdrawn.

Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 39-44 and 51-56 stand rejected under 35 U.S.C. § 112, second paragraph. Applicant respectfully traverses this rejection because one skilled in the art would indeed recognize that, by definition, the above-identified claims are directed to mixtures of different compounds.

Claim 51, for example, recites a "method for preparing a ***combinatorial library***" (emphasis added). The term "combinatorial library" is recognized by those skilled in the art as a mixture of ***different*** oligomeric entities. For example, in a presentation to the United States Patent & Trademark Office ("PTO") entitled "Combinatorial Technology" (Exhibit A),

Supervisory Patent Examiner Jyothsna Venkat articulated that art-accepted definition of a "combinatorial library" is a collection of ***different molecules***:

> "[a combinatorial library is] [a]n intentionally created ***collection of differing molecules*** which can be prepared either synthetically or biosynthetically"

(Exhibit A at 7) (emphasis added). That one skilled in the art would recognize that "differing molecules" are prepared by using Applicant's claimed methods is further supported by the claims themselves. In this regard, Applicant's claims recite ***six different*** aminodiol monomer subunit structures from which the many different oligomeric compounds comprising the library are made:

> reacting said free hydroxyl groups with further aminodiol monomer subunits having structure I, II, III, IV, V, or VI thereby forming an oligomeric compound . . .

(Applicant's claim 51, step (d)). Moreover, there is no language in the claims that would lead one skilled in the art to conclude a different meaning is intended, or, as alleged in the Office Action, that the claims describe a "pure single polymer preparation."

Since the claim terms are well known to those skilled in the art (and, thus, would not present any impediment in determining whether a library or method of interest is or is not within the scope of the claims), the claims are definite within the meaning of the patent laws. *In re Mercier*, 185 U.S.P.Q. 774 (C.C.P.A. 1975) (claims sufficiently define an invention so long as one skilled in the art can determine what subject matter is or is not within the scope of the claims). Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, is respectfully requested.

Obvious-Type Double Patenting

Claims 31-44 have been rejected under the judicially-created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 23 and 24 of commonly-owned U.S. Patent No. 6,184,389 to Hebert ("the 389 patent"). Applicant requests that this rejection be deferred pending some identification of allowable subject matter, as it likely can be readily resolved (depending upon the subject matter ultimately allowed) through the filing of a suitable terminal disclaimer.

Claims 45-56 also have been rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-12 of the 389 patent in view of either U.S. Patent No. 5,112,962 to Letsinger et al. ("the 962 patent") or U.S. Patent No. 5,015,733 to Smith et al. ("the 733 patent"). Here also, Applicant requests that this rejection be deferred pending some identification of allowable subject matter, as it likely can be readily resolved (depending upon the subject matter ultimately allowed) through the filing of a suitable terminal disclaimer.

Claims 31-56 have been rejected for obviousness-type double patenting as allegedly being unpatentable over claims 1-47 and 50-54 of commonly-owned U.S. Patent No. 6,448,373 to Cook et al. ("the 373 patent"). Applicant respectfully traverses this rejection.

An obviousness-type double patenting rejection is "analogous to [a failure to meet] the non-obvious requirement of 35 U.S.C. § 103" except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 U.S.P.Q. 29 (CCPA 1967); MPEP § 804 at 800-22. The analysis employed in an obviousness-type double patenting rejection must satisfy the same standards applicable to a rejection under §

103, except that only the claims of the earlier patent (rather than the disclosure) may be used as prior art. *In re Braat*, 937 F.2d 589, 19 U.S.P.Q.2d 1289 (Fed. Cir. 1991); *In re Vogel*, 422 F.2d 438, 441-42 (C.C.P.A. 1970); MPEP § 804 at 800-22. Such analysis requires, among other things, a determination of the scope and content of the pertinent prior art and an identification of the differences between it and the claims at issue. *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 989, 991 (Fed. Cir. 1988). Moreover, to establish a *prima facie* case of obviousness, "there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant." *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998).

Significantly, the Office Action fails to provide any reason why a person of ordinary skill in the art having the 373 patent claims before him would have been motivated to prepare any compound or practice any method recited in instant claims 31-56. Although the Office Action appears to allege that certain compounds embraced by the broad claims of the 373 patent would also fall within the scope of the instant claims, it is not seen how such a situation, if true, would form a basis for rejection. The Office Action, for example, does not cite any legal authority indicating that a rejection may be entered for obviousness-type double patenting in situations in which a broad prior claim includes compounds within the scope of a claim at issue, nor does the Office Action explain why a person of ordinary skill having the 373 patent claims before him would have been motivated to make the many selections that would have been necessary to yield a compound recited in Applicant's claims. Absent some evidence suggesting a reason why those of ordinary skill would have been motivated to make the required selections, Applicant respectfully requests that the rejection for alleged double patenting in view of the 373 patent be

reconsidered and withdrawn. *Ex parte Kuhn*, 132 U.S.P.Q. 359 (Pat. Off. Bd. App. 1961) (fact that one might arrive at claimed product by making certain selections does not render the product obvious in the absence of some reason for making the selections).

Alternatively, claims 31-56 have been rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-47 of the 373 patent in view of either U.S. Patent No. 5,112,962 to Letsinger et al. ("the 962 patent") or U.S. Patent No. 5,015,733 to Smith et al. ("the 733 patent"). Applicant respectfully traverses this rejection for the same reasons noted above. The Office Action fails to provide any reason why a person of ordinary skill in the art having these claims before him would have been motivated to prepare any compound or practice any method recited in instant claims 31-56. Accordingly, reconsideration and withdrawal of the rejections based upon the combination of the 373 patent with either the 962 patent or the 733 patent is respectfully requested.

Claims 31-44 have been rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-22 of commonly-owned U.S. Patent No. 5,886,177 to Cook et al. ("the 177 patent"). Applicant respectfully traverses this rejection because the Office Action fails to provide any reason why a person of ordinary skill in the art having these claims before him would have been motivated to prepare any compound or practice any method recited in instant claims 31-44. Although the Office Action appears to allege that certain compounds embraced by the broad claims of the 177 patent would also fall within the scope of the instant claims, it is not seen how such a situation, if true, would form a basis for rejection. The Office Action, for example, does not cite any legal authority indicating that a rejection may be entered for obviousness-type double patenting in situations in which a

broad prior claim includes compounds within the scope of a claim at issue, nor does the Office Action explain why a person of ordinary skill having the 177 patent claims before him would have been motivated to make the many selections that would have been necessary to yield a compound recited in Applicant's claims. Absent some evidence suggesting a reason why those of ordinary skill would have been motivated to make the required selections, Applicant respectfully requests that the rejection for alleged double patenting in view of the 177 patent be reconsidered and withdrawn. *Ex parte Kuhn*, 132 U.S.P.Q. 359 (Pat. Off. Bd. App. 1961) (fact that one might arrive at claimed product by making certain selections does not render the product obvious in the absence of some reason for making the selections).

Claims 45-56 have been rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-22 of the 177 patent in view of either U.S. Patent No. 5,112,962 to Letsinger et al. ("the 962 patent") or U.S. Patent No. 5,015,733 to Smith et al. ("the 733 patent"). Applicant respectfully traverses this rejection because, as noted above, the Office Action fails to provide any reason why a person of ordinary skill in the art having these claims before him would have been motivated to prepare any compound or practice any method recited in instant claims 45-56. Accordingly, reconsideration and withdrawal of the rejections based upon the combination of the 177 patent with either the 962 patent or the 733 patent is respectfully requested.

Rejections Under 35 U.S.C. § 103(a)

Claims 31-38 and 45-56 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over the claims of the 373 patent taken alone, or, alternatively, in view of either

U.S. Patent No. 5,112,962 to Letsinger et al. ("the 962 patent") or U.S. Patent No. 5,015,733 to Smith et al. ("the 733 patent").[1]

To establish a *prima facie* case of obviousness, however, "there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant." *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998). "In other words, the examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998).

The Office Action fails to provide any reason why a person of ordinary skill in the art having the claims of the 373 patent before him would have been motivated to prepare any compound or practice any method recited in instant claims 31-38 and 45-56. Although the Office Action appears to allege that certain compounds embraced by the broad claims of the 373 patent would also fall within the scope of the instant claims, it is not seen how such a situation, if true, would form a basis for rejection. The Office Action, for example, does not cite any legal authority indicating that a rejection may be entered for obviousness-type double patenting in situations in which a broad prior claim includes compounds within the scope of a claim at issue, nor does the Office Action explain why a person of ordinary skill having the 373 patent claims before him would have been motivated to make the many selections that would have been

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[1] Applicant notes that the basis for the rejection is the same as that set forth in support of the alleged obviousness-type double patenting rejection (Office Action at 11). Accordingly, the Office Action has relied upon (and Applicant will base his response on) only the claims of the 373 patent.

necessary to yield a compound recited in Applicant's claims. Absent some evidence suggesting a reason why those of ordinary skill would have been motivated to make the required selections, Applicant respectfully requests that the rejection for alleged double patenting in view of the 373 patent be reconsidered and withdrawn.

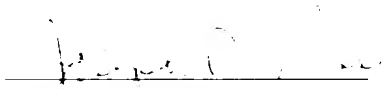
Conclusion

Applicant believes that the present claims are now in condition for allowance.

An early Office Action to that effect is, therefore, earnestly solicited.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

Respectfully submitted,



Joseph D. Rossi
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Date: February 5, 2003
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VERSION WITH MARKINGS TO SHOW CHANGES MADE

Please amend the application as follows:

In the Specification:

At page 1, line 1 of the specification, please delete the Title and replace it with the following new Title: --**OLIGOMERIC AMINODIOL-CONTAINING COMPOUNDS, [AND] LIBRARIES THEREOF [OF SUCH COMPOUNDS COMPRISING A PLURALITY OF AMINODIOL MONOMER SUBUNITS] AND PROCESS OF PREPARING THE SAME** --.

At page 1, replace the paragraph beginning on line 3 with the following replacement paragraph:

This application is a continuation-in-part of United States Application Serial No. 08/483,311, filed [6/7/95] June 7, 1995, now U.S. Patent No. 6,184,389, which is a continuation-in-part of [PCT] International patent application Serial No. PCT/US95 /00356 filed [1/11/95] January 11, 1995, which is a continuation-in-part of United States Application Serial No. 08/180,134, filed [1/11/94] January 11, 1994, now U.S. Patent No. 5,519,134, which is a continuation in part of United States Application 08/179,970, filed [1/11/94] January 11, 1994, which issued on [5/21/96] May 21, 1996 as U.S. Patent [Serial] No. [5519134] 6,448,373. Each of these patent applications are assigned to the assignee of this application and are incorporated by reference herein.

At page 114, replace the paragraph beginning on line 19 with the following replacement paragraph:

Using the above, libraries are prepared from oligomeric compounds that are [diveratized] derivatized with one, two, three, four, or more of the following acid halides available from Aldrich Chemical Company, Inc., Milwaukee, WI. The Aldrich catalog number is given in the right hand column and the compound name in the left hand column:

In the Abstract:

Please add the following Abstract of the Disclosure after the claims in the above identified patent application:

--Oligomeric compounds comprising a plurality of aminodiol monomer subunits joined by linking groups are provided, as well as libraries of such compounds and processes for preparing the oligomeric compounds and libraries.--

ABSTRACT OF THE DISCLOURE

(Replacement Sheet)

Oligomeric compounds comprising a plurality of aminodiol monomer subunits joined by linking groups are provided, as well as libraries of such compounds and processes for preparing the oligomeric compounds and libraries.